

REMARKS

Claims 1, 2 and 6 are currently pending in the present application, with Claim 6 being newly added. In the Office Action, Claims 1 and 2 have been rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent Application Publication No. EP 1039 768 A2 (Sim) in view of Deluca (U.S. Patent No.: 5,784,001).

The Applicant wishes to thank the Examiner for withdrawing the rejection in view of the submitted 131 Affidavit.

Reconsideration of the instant application in view of the above amendments and the following remarks is respectfully requested.

Sim discloses a data transmitting and receiving apparatus and method for a digital mobile station.

Deluca discloses that once the data communication receiver has decoded and stored a message, message reception is announced to the user by, for example, an alert such as an audible tone or predetermined icon. For instance, some prior art devices include a standby display that presents a single, triangular icon for each stored message such that the user can determine the number of messages stored in the receiver. Data communication receivers employ predetermined icons to provide other information, e.g., low battery or out-of-range status, as well. (See col. 1, lines 18-27).

Regarding independent Claim 1, the Examiner states that Sim discloses, “a method of transmitting data, such as graphic data (using a data transmitting apparatus of Fig. 2).” After reviewing Sim, it is respectfully submitted that the Examiner is incorrect.

More particularly, to support the rejection, the Examiner states that Sim (in paragraphs 0025, 0032, Figure 2 #28) discloses the above recitation. However, Sim does not disclose “temporarily storing the image file included in SMS message in the memory, and storing the image file after

assigning it a name in accordance with a receiving user request, as recited in Claim 1.

Specifically, the Examiner alleges that this novel feature of Claim 1 is taught in paragraph 0046 of Sim. However, this passage of Sim only discloses that the original data of the received SMS blocks is decoded if the SMS blocks are received, and the decoded data is stored in the specified storage regions of the graphic data storage section 38 implemented in a Flash memory. This invention claims a different feature as articulated above. Deluca fails to cure Sim's deficiencies.

Based on the above, neither Sim nor Deluca, combined or alone, disclose, teach or fairly suggest displaying the novel feature recited in Claim 1. To establish a prima facie case of obviousness under 35 U.S.C. §103(a) based upon a combination of references, the cited combination of references must disclose, teach or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881(C.C.P.A. 1981). All of the claimed features of independent Claim 1 are not taught or suggested by the combination of Sim and Deluca or by either reference alone. Accordingly, the Examiner fails to establish a prima facie case of obviousness with respect to Claim 1. As the combination of Sim and Deluca does not disclose at least the above elements of Claim 1, withdrawal of the rejection is respectfully requested.

Accordingly, independent Claim 1 is believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 2 and 6, they are likewise believed to be allowable by virtue of their dependence on Claim 1. Accordingly, reconsideration and withdrawal of the rejection of dependent Claim 2 is also respectfully requested.

Therefore, all of the claims pending in the Application, namely, Claims 1, 2 and 6, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul J. Farrell", is written over a horizontal line.

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